

REMARKS

Within the present application claims 4, 18, and 24-31 have been canceled in response to the restriction requirement which has been held proper and final in the present official action by the PTO. Additionally, claims 5 and 6 have been canceled since the subject matter of the claims has been incorporated into newly amended claim 1. Newly amended claim 1 now incorporates the limitations that the substrate is has a density less the polymeric gel and comprises a foamed polymer.

Claims 12 and 22 have been canceled to alleviate the objection regarding the isocyanate being indefinite as a prepolymer under 35 USC § 112. Furthermore, the cancellation of claims 12 and 22 removes the claim objection to the spelling of the term “polyisocyanates”.

Independent claim 16 has been newly amended to include the subject matter of claim 17 which recites that the substrate is comprised a foamed polymer. Thus, claim 17 has been canceled. Claims 1- 3, 7-11, 13-16, and 19-23 are currently pending.

DRAWING/SPECIFICATION OBJECTIONS

The drawings have been objected to because they include a reference character not mentioned in the description. Specifically, the number 12 in Figure 2 was not referenced. Application has amended the specification on page 8, paragraph 1 to add the number “12” after the term “perforations”. The description now references the number 12 as the perforations to comply with 37 CFR 1.84(p)(5).

REJECTIONS UNDER 35 U.S.C. § 102 (b)

Within the present official action claims 1-3, 5 and 16 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Number 5,066,259 to *Acker*.

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

Applicant has amended the above referenced claims to include the limitation that the substrate is comprised of a foamed polymeric material as is recited in either claim 6 or 17. The cited reference fails to teach each and every claim element in the newly amended claims since the reference is silent as teaching a foamed substrate. Thus, Applicant respectfully requests that the present rejection be withdrawn as to claims 1-3, 5 and 16 under 35 U.S.C. § 102(b) as being anticipated by *Acker*.

REJECTIONS UNDER 35 U.S.C. § 103(a)

The newly amended claims in the present official action all include the limitations as recited in either claims 6 and 17 wherein the substrate was recited as comprising a foamed polymeric material. Thus, only the rejections under 35 U.S.C. § 103(a) specifically directed to claims 6, 7 and 17 will be addressed in depth since remaining objections are not noted by the PTO as teaching or suggesting a substrate comprised of a foamed polymeric material. Given that all the present pending claims include the limitation of foamed polymeric material the remaining objections neither teach nor suggest that which claimed in the newly amended claims.

Rejection under 35 U.S.C. 103(a) *Acker* in further view of *Hills*

Within the present Official Action claims 6, 7 and 17 have been rejected under 35 U.S.C. 103(a) as being unpatentable over *Acker* in further view of U.S. Patent Number 4,170,086 to *Hills*. The PTO states that *Acker* does not specifically disclose a doll structure wherein the core is made from a foamed polymeric material. However, the PTO states that *Hills* teaches a stuffed toy animal wherein the stuffing material can be made from a PCV foam, mat or natural or synthetic fiber. The PVC foam has been held by the PTO to be an equivalent material to a fiber mat to add the weight and bulk to a toy. Thus, the PTO contends that it would have been obvious to one of ordinary skill in the art to substitute PVC foam for the fiber mat of *Acker* since the two materials give weight and bulk to a toy.

For a reference to be relied upon under 35 U.S.C. § 103(a) it must be analogous art. MPEP 2141.10(a). "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." MPEP 2141.01(a) citing *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

Applicant respectfully contends that the cited references are not in the same field as applicant's endeavor and are thus are not analogous to claimed invention. Applicant's field of endeavor is shock-attenuating elastomeric pads. As noted in the Field of the Invention, the claimed invention is related shock-attenuating elastomeric pads having a reinforcing material. Applicant's endeavor is protective equipment that attenuates shock. The cited art's field of endeavor is directed to the manufacture of lifelike Doll's. The two endeavors are not in the same

field. Applicant respectfully contends that doll manufacture and protective equipment are not in the same field of endeavor and the cited art is not analogous to that which is claimed in the present application.

Given that the fields are not related the second prong of the test then asks if the cited art is reasonably pertinent to the particular problem with which the inventor was concerned. The present invention provides a solution to the problem of injuries caused by impacts. The Background section of the application thoroughly describes the need for protective impact absorbing materials in contact sports. (For example, Pg. 1, first paragraph) The inventor is concerned with the problems resulting from impacts. The inventor's invention is a shock-attenuating elastomeric pad. The pad attenuates the shock and thus reduces or eliminates the problems associated with shock, which is the inventor's concern. The cited art is related to Doll manufacture whose stated concerns are creating a lifelike doll. Creating a realistic doll is not reasonably pertinent to the particular problem with which the inventor is concerned, which is shock attenuation.

Thus, Applicants respectfully contend that the cited art may not be relied upon 35 U.S.C. § 103(a) since the art is not analogous to that of the inventor's claimed invention.

Applicants note that the PTO cites in the 35 U.S.C. § 102(b) rejection that *Acker* does not disclose a shock-absorbing envelope. The PTO asserts that the doll structure meets all the structural limitations as required by the cited claims and thus would be a shock-absorbing envelope. Applicants would like to point out that the standard under 35 U.S.C. § 103(a) requires the art to be analogous for it to be cited. As noted above, the cited art is not analogous and cannot be used in a 35 U.S.C. § 103(a) rejection.

Applicant further notes that one would not have been motivated to add the foamed PVC taught in *Hills* to that of *Acker*. The PTO states that one would be motivated to substitute PVC foam for the fiber mat of *Acker* since the two materials give weight and bulk to a toy. Applicant adds a foamed PVC to reduce weight and not to add weight as suggested by the PTO. The reinforcing material is added to reduce the weight of the pad and to add rigidity. Page 8, Lns 1-2 of the present specification. Thus, the prior art actually teaches away from that which is claimed in the present application in that it teaches the adding of weight.

Furthermore, *Acker* is directed to creating a doll that possesses a weight factor approximately equivalent to the weight factor of a human child. Abstract. The *Acker* reference desires to add weight. Foam is a lightweight material. Thus, one would not be motivated to add a lightweight foam to that taught in *Acker*.

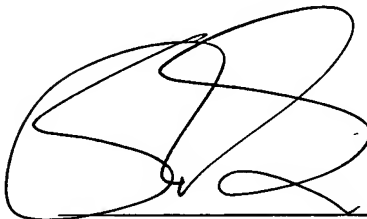
Additionally, the *Acker* reference adds a compressible material to simulate the “feel” of human tissue. Applicant claims a shock-attenuating elastomeric pad. One of ordinary skill in the art would not take that which is taught in *Acker* and modified by *Hills* to create a shock-attenuating elastomeric pad. As stated by the PTO, *Acker* does not disclose a shock absorbing envelope. Pg. 4, Paragraph 8, Ln. 7. The combined cited art does not suggest the formation of shock-attenuating elastomeric pad. The cited art only teaches the formation of dolls and in particular to dolls that have lifelike features. For example, the *Acker* reference teaches the lifelike “feel” of human tissue.

Applicant respectfully contends that the combined cited art does not teach or suggest that which is claimed in the newly amended claims.

CONCLUSION

Applicant respectfully contends that claims 1- 3, 7-11, 13-16, and 19-23 are allowable and an early notice of such effect is earnestly solicited. Should the Examiner have any questions or comments regarding the foregoing Response, she is invited and urged to telephone the undersigned attorney.

Respectfully Submitted,



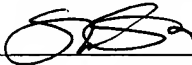
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